

REMARKS

Amendment to the Specification

The specification has been amended to indicate the status of nonprovisional parent applications to which priority is claimed. No new matter has been added.

Allowable Subject Matter

Applicants acknowledge that Claim 16 has been allowed in the Office Action.

Election/Restriction

Applicants acknowledge that the restriction requirement has been withdrawn.

Rejection of Claims 1-13, 17-20, 22, 24, 26 and 28 Under 35 U.S.C. §112, First Paragraph

Claims 1-13, 17-20, 22, 24, 26 and 28 are rejected under 35 U.S.C. §112, first paragraph, because, according to the Office Action, the specification does not enable any person skilled in the art to which it pertains to use the invention commensurate in scope with the instant claims. Specifically, the Office Action states that the specification as filed does not enable the scope of the claims. The Office Action does indicate that *in vitro* and *in vivo* methods of the invention are enabled for SEQ ID NOS: 28 and 47.

Applicants respectfully submit that one skilled in the art would be taught by the specification how to practice the claimed invention without undue experimentation. As previously argued, the specification accurately teaches how to practice the claimed invention. One skilled in the art could easily reproduce Applicants' results by simply following the examples and the disclosed oligonucleotides. As to other oligonucleotides, undoubtedly some screening using the methods disclosed in the specification and examples would be required. However, these experiments, which would require no modification of the disclosed assays, would not be undue. The fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation. *Massachusetts Institute of Technology v. A.B. Fortia*, 227 U.S.P.Q. 428 (Fed. Cir. 1985) In the antisense field, scientists typically engage in such screening, and would have to do so no matter how many oligonucleotides are exemplified. In addition, the enablement requirement is met if the description enables any mode of making and using the invention. *Johns Hopkins University v.*

Chen et al.

Application No. 09/541,848

Page 8 of 8

Cell Pro Inc., 47 U.S.P.Q.2d 1705, 1718 (Fed. Cir. 1998), citing *Engel Indus., Inc. v. Lockformer Co.*, 20 U.S.P.Q.2d 1300, 1304 (Fed. Cir. 1991). Applicants have clearly met this requirement. Accordingly, the rejection of Claims 1-13, 17-20, 22, 24, 26 and 28 for non-enablement was in error. Reconsideration and withdrawal of the rejection are respectfully requested.

Notice of Appeal

Applicants will await an Advisory Action before filing a Notice of Appeal.

CONCLUSION

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,

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